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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,010	06/23/2003	Bruce Edward Stuckman	1033-T00531	7678
60533	7590	03/16/2006		EXAMINER
TOLER SCHAFFER, LLP				BASHORE, WILLIAM L
5000 PLAZA ON THE LAKES				
SUITE 265			ART UNIT	PAPER NUMBER
AUSTIN, TX 78746			2176	

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/602,010	STUCKMAN ET AL.	
	Examiner	Art Unit	
	William L. Bashore	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 February 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-34 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Request for Reconsideration (hereinafter the Request) filed 1/23/2006, to the original application filed 6/23/2003, IDS filed 10/20/2003.
2. Claims 1-34 pending. Claims 1, 24 are independent.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsumi, Yoshimasa (hereinafter Utsumi), European Patent No. EP 1 160 708 A1, published December 5, 2001, in view of BountyQuest Website (hereinafter BountyQuest), <www.bountyquest.com>, 5/15/2001, downloaded via archive.org on 11/1/2005, pages 1-29 (listed in a previous action – please note that the examiner references page numbers at bottom of the BountyQuest reference).**

In regard to independent claim 1, Utsumi teaches a method of assessing possible patent infringement (Utsumi Abstract, para [0013]) whereby information is posted on a Website seeking possible infringement information regarding a particular patent, etc. (Utsumi para [0023], [0024], [0025]). If a user wishes to input a possible infringement target, he/she can do so via an input form (Utsumi para [0027], [0028], [0029], [0030]).

Utsumi teaches an input form field for inputting detailed infringement information (Utsumi para [0030] window 23). Said window 23 is offered for input of infringement target information, with the size of said window providing the capability of inputting as much information as may be necessary. Utsumi also teaches an

embodiment which allows solicitation of opinions (Utsumi para. [0064]). Utsumi does not specifically teach a second user input to describe how said target meets the criteria, or of indication of an infringement target. However, BountyQuest teaches an input form for a user to enter information, including multiple areas for describing how the infringement target meets the criteria (BountyQuest, page 16 section “Required Elements”). Above this is an input window indicating “The article clearly describes a device for changing hot lightbulbs with the hinges described in claim 5 of the...” (BountyQuest page 16 “Description/Comments”)). The examiner fairly interprets this teaching as directed to the user identifying an infringement target. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description and target. Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claim 2, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of input boxes for the second input. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria (BountyQuest, page 16 section “Required Elements”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner. Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claim 3, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of input boxes for the second input, each box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria, one box per limitation (BountyQuest, page 16 section “Required

Elements”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner. Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claim 4, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of areas displaying infringement criteria portions, with each input box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria, one box per displayed infringement limitation (BountyQuest, page 16 section “Required Elements”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner. Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claims 5-6, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of areas displaying infringement criteria portions (claim limitations), with each input box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria, one box per displayed infringement limitation (BountyQuest, page 16 section “Required Elements”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner (i.e. columnar fashion, etc.). Both references are in the same general field of endeavor,

since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claims 7-8, Utsumi teaches an input box for inputting infringement information in natural language text (Utsumi's Figure 3 accepts natural (i.e. English, etc.) language input).

In regard to dependent claims 9-11, Utsumi teaches a Web form (Utsumi para [0027]). Utsumi teaches identification of a product, and a company (Utsumi para [0006], [0028]).

In regard to dependent claim 12, Utsumi teaches a submission judged (evaluated) by a server management company (Utsumi para [00028]).

In regard to dependent claims 13-17, Utsumi teaches judgment by a patent attorney (Utsumi para [0037]). A reward is issued for a first on-point submission accordingly, along with deals, fixed and/or variable fees etc. (Utsumi para [0037] to [0041]).

In regard to dependent claims 18, Utsumi teaches submission via e-mail, which contains a date and time stamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply a date and time stamp of submission, providing the benefit of timely submissions in case of disputes, etc.

In regard to dependent claim 19, Utsumi does not specifically teach a receipt. However, BountyQuest teaches recordation of a session ID and timestamp, as well as instructions to print a copy of the confirmation

page (BountyQuest page 15). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi the benefit of receipts for confirming submissions.

In regard to dependent claims 20-21, Utsumi teaches a suitable network (Utsumi para [0049], Figure 4 item 3). Although an “intranet” is not specifically disclosed, Utsumi does teach said network as the Internet (Utsumi para [0024]), providing reasonable suggestion to one of ordinary skill in the art at the time of the invention to utilize an intranet instead (intranet is contained, while the Internet is global), providing the benefit of increased security for seeking infringement of classified patents, etc.

In regard to dependent claim 22, although Utsumi does not specifically teach “graphical” input, nevertheless, Utsumi teaches nearly any type of communication mechanism for reporting information, including e-mail (Utsumi para [0051]). Since it is well established that e-mail has the capacity of attaching files (i.e. a pdf file, which is an image based document, diagrams, etc.), it would have been obvious to one of ordinary skill in the art at the time of the invention to provide graphical input such as diagrams and/or pdf as an e-mail attachment, providing the benefit of allowing a wide range of input from various sources.

In regard to dependent claim 23, Utsumi teaches multiple languages (Utsumi para [0026], Figure 2).

In regard to independent claim 24, claim 24 reflects the article of manufacture comprising computer readable instructions used for performing the methods as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 25-34, claims 25-34 reflect the article of manufacture comprising computer readable instructions used for performing the methods as claimed in claims 2-9, 22-23, respectively, and are rejected along the same rationale.

Response to Arguments

5. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues on page 6 of the Request that Utsumi does not teach inputting an infringement target. It is respectfully submitted that since a goal of Utsumi's invention is to solicit infringement information, the user must make the server aware of what the target is. BountyQuest also teaches this (see rejection of claim 1).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2176

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER

March 09, 2006